

REMARKS

The Official Action dated September 26, 2001 has been carefully considered.

Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 1 and 18 have been amended to further define the present invention. Claim 7 was amended to correct a typographical error. Claim 5 has been cancelled. Attached hereto is "**Version With Markings To Show Changes Made**," showing the changes made to the claims by the current amendment. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claims 1-9, 11-13, 15-16, and 18-22 under 35 U.S.C. § 102(b) as being anticipated by Levine (U.S. Patent No. 4,751,583). The Examiner asserted that Levine teaches a stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium, the printing apparatus comprising: an input member for receiving the one or more digital photographs from a source; image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying the images and for selecting one or more of the digital photographs for a printed page; and a print control for producing on the printable medium a pattern associated with the printed page.

However, as will be set forth in detail below, it is submitted that the printer apparatuses and methods using the same defined by claims 1-9, 11-13, 15-16 and 18-22 are not anticipated by the teachings of Levine. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to stand-alone printer apparatuses. The stand-alone printing apparatuses comprise: an input member for receiving said one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying said images and for selecting one or more of said digital photographs for a printed page; at least one drive for receiving a computer readable medium, wherein said source is a computer readable medium disposed in said drive; and a print control for producing on said printable medium a pattern associated with said printed page.

Levine discloses a portable electronic still camera and image previewing and processing system.

While Levine discloses a portable electronic image previewing and processing system which includes a copier-printer, there is no teaching or disclosure of the copier-printer being a stand-alone printing apparatus or have the features and capabilities of a stand-alone printing apparatus as defined in the present specification. As discussed at page 7 of the present specification, "stand-alone" means that the printer is capable of processing and printing digital files independent of an external host device, such as a computer, wherein "processing" means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file. The Examiner states that the copier-printer of Levine is a stand-alone printing apparatus. Applicants assert that Levine fails to teach or disclose to one skilled in the art of the capabilities of the copier-printer. The only disclosure of the capabilities of the Levine copier-printer is "[a]s disclosed in earlier patents above, the transferred image may also be optically previewed on the display screen 23 of the copier-printer 22 before a hard-copy is printed, and, if desired at that later time, the image can be further processed or improved at the copier-printer 22 to provide a more legible or otherwise enhanced print." (See column 3, lines 55-61). Further,

the reference must describe the Applicant's claimed invention sufficiently to place a person of ordinary skill in the field of the invention in possession of it. *Akzo N. V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987); *In re Coker*, 463 F.2d 1344, 1348, 175 U.S.P.Q. 26, 29 (CCPA 1972). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Applicants find no teaching or suggestion by Levine of a printer capable of processing and printing digital files independent of an external host.

Furthermore, Levine fails to teach the stand-alone printing apparatus having a drive for receiving computer readable medium, wherein the computer readable medium contains the source for one or more digital photographs. Anticipation under 35 U.S.C. § 102(b) requires a disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). In view of the failure of Levine to teach a stand-alone printing apparatus with at least one drive for receiving computer readable medium, Levine does not disclose each element of the claims and therefore does not anticipate the presently claimed stand-alone printer apparatus and methods using the same, whereby the rejection under 35 U.S.C. § 102 (b) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 10 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine in further view of McCann et al (U.S. Patent No. 5,963,939). The Examiner noted that Levin does not teach the different states comprise a device view in which a graphical representation of the photoprinter and any attached devices is depicted on the video

display. The Examiner asserts that McCann et al teach a display would be used in a state of viewing devices in which a graphical representation is depicted on the video display. The Examiner asserted it would have been obvious to a person with ordinary skill in the art at the time of the invention to have modified Levine to include the device view in which a graphical representation of the photoprinter and any attached devices is depicted on the video display.

However, as will be set forth in detail below, it is submitted that the stand-alone printing apparatus of claims 10 and 14 are non-obvious and patentably distinguishable from the teaching of Levine in view of McCann. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 10, the present invention is directed to stand-alone printer apparatuses. The stand-alone printing apparatus comprises the printing apparatus of claim 1 and the user interface comprises an operator panel having a plurality of activating members for initiating instructions to the user interface, and wherein the video display is located on the operator panel. The user interface further comprises a plurality of different states, and wherein the video display varies between the different states. The different states comprise an image view in which an image is depicted on the display, and a page view in which a page is depicted on the video display. The different states further comprise a device view in which a representation of the of the printing apparatus and any attached devices are depicted on the video display.

McCann et al disclose an object-driven application tool which allows a Value Added Reseller (VAR) to access a large body of publicly available information about computing devices and to identify the needs of a particular customer or end user and to select an appropriate solution of equipment, hardware, and networking products to meet the customer's needs.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d. 1941 (Fed.Cir. 1992). Similarly, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, U.S.P.Q.2d. 1276 (Fed. Cir. 1987). Applicants find no such teaching, suggestion or incentive for the combination of Levine and McCann et al. One skilled in the art would not have been motivated to combine the VAR application tool of McCann with the portable electronic still camera and image previewing and processing system of Levine.

It is therefore submitted that the presently claimed stand-alone printing apparatuses are non-obvious over and patentably distinguishable from Levine in view of McCann, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine and further in view of Matsumoto et al (U.S. Patent No. 5,796,428). The Examiner noted that Levine does not teach an image view and a page view being shown simultaneously on the video display. The Examiner asserted that Matsumoto et al teach a display image view (Fig. 25, 2501) and a page image view (Fig. 25, page 1) simultaneously on a video display. The Examiner asserted it would have been obvious to a person with ordinary skill in the art to have modified Levine to include displaying the image view and the page view simultaneously on the video display.

However, as will be set forth in detail below, it is submitted that the stand-alone printing apparatus of claim 17 is non-obvious and patentably distinguishable from the teaching of Levine

in view of Matsumoto et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 17, the present invention is directed to a graphical user interface for a stand-alone photoprinter capable of transferring a digital photograph from a source to a printable medium. The user interface comprises: a video display integrated within the photoprinter for graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; and a plurality of different states in which to depict information on the video display, one of the states being active at a time, the user interface moving between active states in response to activation of one or more of the activating members. The different states comprise an image view in which an image corresponding to a digital photograph is depicted on the video display, and a page view in which a page comprised of selected images is depicted on the video display. The page view is comprised of digital photographs selected in the image view. The image view and the page view are shown simultaneously on the video display, and wherein the active state varies between the image view and the page view by activating one of the activating members.


The Examiner's attention is directed to Figs. 11a, 11b, and 12 of the present specification. In these Figures the image view and the page view are shown simultaneously on the video display. The image view is on the left portion of the video display and the page view is on the right portion of the video display. The Examiner has asserted that Fig. 25 of Matsumoto et al teach an image view and a page view simultaneously on the video display. However, Applicants find no teaching, disclosure or suggestion of Matsumoto et al, alone or in combination with Levine, of a graphical user interface on which the image view and the

page view are shown simultaneously on the video display, and wherein the active state varies between the image view and the page view by activating one of the activating members.

It is well settled that to support a rejection under 35 U.S.C. § 103(a), a reference must provide an enabling disclosure, i.e., it must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). In view of failure of Levin and Matsumoto et al, alone or in combination to teach or suggest a graphical user interface on which the image view and the page view are shown simultaneously on the video display, and wherein the active state varies between the image view and the page view by activating one of the activating members, Levin in view of Matsumoto et al do not provide an enabling disclosure of the presently claimed graphical user interface for a photoprinter and does not place the presently claimed graphical user interface in the possession of the public. The Examiner's effort to establish obviousness is unavailing. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Levin and Matsumoto et al, alone or in combination, fail to teach or suggest a graphical user interface on which the image view and the page view are shown simultaneously on the video display, and wherein the active state varies between the image view and the page view by activating one of the activating members. Thus, Levin in view of Matsumoto et al do not support a rejection under 35 U.S.C. § 103. It is therefore submitted that the presently claimed graphical user interfaces are non-obvious over and patentably distinguishable from Levin in view of Matsumoto et al, whereby the rejection under 35 U.S.C. § 103(a) has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§ 102 and 103 and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please cancel claim 5.

Please amend claims 1, 7 and 18 as follows:

1. (Amended) A stand-alone printing apparatus for transferring one or more digital photographs captured by a digital device to a printable medium, said printing apparatus comprising:

an input member for receiving said one or more digital photographs from a source;

an image processor for generating an image corresponding to each digital photograph;

an integrated graphical user interface with a video display for displaying said images

and for selecting one or more of said digital photographs for a printed page; [and]

at least one drive for receiving a computer readable medium, wherein said source is a computer readable medium disposed in said drive; and

a print control for producing on said printable medium a pattern associated with said printed page.

7. (Amended) The stand-alone printing apparatus of claim [7] 6, wherein said different states comprise:

an image view in which an image is depicted on said display, and a page view in which a page is depicted on said display.

18. (Amended) A method for previewing and printing digital photographs on a stand-alone photocopier comprising the steps of:

receiving said digital photographs from a digital photograph source[;], wherein the digital photograph source is a computer readable medium disposed in a drive integrated within said photoprinter;

generating an image for each of said digital photographs in an image processor;
providing a user interface having a video display integrated within said photoprinter;
activating an image view in said user interface to display said images on said video display;
selecting from amongst said displayed images to form a printed page;
activating a page view in said user interface to preview said printed page on said video display; and
instructing a print control in said photoprinter to produce a pattern associated with said printed page on a print medium.